

**Remarks/Arguments**

This amendment is submitted in response to the Office Action of July 9, 2003, identified as Paper No. 11. Claims 33-54 remain pending in the application.

Claims 38-52 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 45-48 and 53 were rejected under 35 U.S.C. § 103(a) as obvious in light of GB 2,274,184 to McIntosh ("McIntosh") and U.S. Patent No. 5,944,824 to He ("He"). Claim 49 was rejected under 35 U.S.C. § 103(a) as obvious in light of *McIntosh* and *He*, in further view of U.S. Patent No. 6,088,143 to Bang ("Bang"). Claims 50-52 and 54 rejected under 35 U.S.C. § 103(a) as obvious in light of *McIntosh* and *He*, in further view of U.S. Patent No. 6,161,185 to Guthrie et al. ("Guthrie"). Claims 33-36, 38, 39, 40 and 41 rejected under 35 U.S.C. § 103(a) as obvious in light of *McIntosh* and *He*, in further view of U.S. Patent No. 6,315,195 to Ramachandran ("Ramachandran"). Claim 37 was rejected under 35 U.S.C. § 103(a) as obvious in light of *McIntosh*, *He*, and *Ramachandran* in further view of *Bang*. Claims 42-44 were rejected under 35 U.S.C. § 103(a) as obvious in light of *McIntosh*, *He*, and *Ramachandran* in further view of *Guthrie*.

The Examiner also rejected the claims in light of several newly found references: U.S. Patent No. 5,732,138 to Noll et al. ("Noll"); the PassMan system disclosed on the internet website [www.ijen.net/passman.htm](http://www.ijen.net/passman.htm) ("the PassMan website"); and the internet website [www.notebooks.com](http://www.notebooks.com) ("Notebooks.com"). Claims 45-48 and 53 were rejected under 35 U.S.C. § 103(a) as obvious in light of *McIntosh* in view of *Noll*. Claims 45-48 and 53 were rejected under 35 U.S.C. § 103(a) as obvious in light of *McIntosh* in view of the PassMan archived website. Claim 49 was rejected under 35 U.S.C. § 103(a) as obvious in light of *McIntosh* and the PassMan archived website, in further view of *Bang*. Claims 50-52 and 54 were rejected under 35 U.S.C. §

103(a) as obvious in light of *McIntosh* and the Passman website, in further view of *Guthrie*. Claims 33-36, 38, 39, 40 and 41 were rejected under 35 U.S.C. § 103(a) as obvious in light of *McIntosh* and the PassMan website, in further view of *Ramachandran*. Claims 37 was rejected under 35 U.S.C. § 103(a) as obvious in light of *McIntosh*, the PassMan website, and *Ramachandran*, in further view of *Bang*. Claims 42-44 were rejected under 35 U.S.C. § 103(a) as obvious in light of *McIntosh*, the PassMan website, and *Ramachandran* in further view of *Guthrie*. Claims 45-48 and 53 were rejected under 35 U.S.C. § 103(a) as obvious in light of the PassMan website in view of Notebooks.com. Claims 33 and 39 were rejected under 35 U.S.C. § 103(a) as obvious in light of the PassMan website and Notebooks.com in further view of *Ramachandran*.

#### **I.      Impropriety of Rejections under 35 U.S.C. § 112, first paragraph**

For the first time, the Examiner rejected claims 38-52 as failing to comply with the written description requirement because the disclosure does not purportedly support claims calling for the association of a plurality of passwords with a plurality of indicia all at once. This rejection, however, is based on an improper application of section 112, first paragraph.

In rejecting a claim under section 112, first paragraph, an examiner must set forth express findings of fact which: (1) identify the claim limitation at issue; and (2) establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. MPEP 2163.04.

Here, the Examiner alleges that the claims are improper because they cover associating numerous passwords with numerous indicia all at once, when the disclosure only teaches sequential storage. Notably, the Examiner was unable to point to any specific claim limitation

that was not described in detail in the specification. Instead, the Examiner created an “indefinite” limitation in an apparatus claim by construing it to recite a way of *using* the claimed invention not disclosed *in hac verba* in the specification. This is not a recognized basis for a rejection under 35 U.S.C. § 112, first paragraph.

The rejected claims are directed to the *structure* for generating and storing random passwords and associated them with selected indicia – not a *method of using* the device. Thus, it is completely irrelevant how the device *might be used* as the structure of the claimed device is fully disclosed in the specification. Indeed, the subject matter, limitations, and terminology used in the claims are undoubtedly present in the specification. Merely because claimed structure may be used in ways not specifically disclosed in the specification does not render the claims invalid for lack of an adequate written description.

## II. Impropropriety of the Rejections under 35 U.S.C. § 103(a) in view of *McIntosh* and *He*

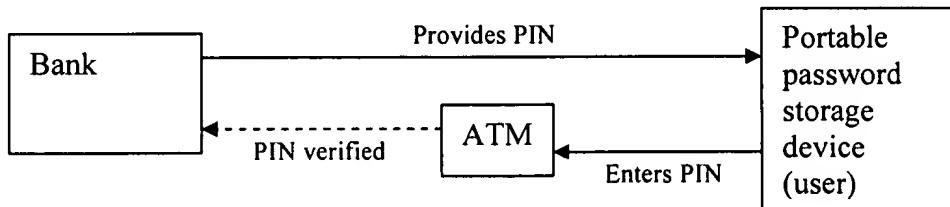
With regard to the rejection of the claims as obvious in view of *McIntosh* and *He*, the Examiner has failed to provide an adequate motivation or suggestion to combine the references to form the claimed invention. According to the Examiner, one of ordinary skill in the art would modify the memory device of *McIntosh* to include circuitry for generating random passwords based on the teaching in *He* that randomized passwords are advantageous to improve security. This generalized teaching in *He* relied on by the Examiner is insufficient to properly motivate the necessary modifications to *McIntosh*. As a result, the Examiner is impermissibly applying hindsight analysis.

*McIntosh* discloses a passive device that merely stores passwords and indicia. In order to modify the device of *McIntosh* to achieve the claimed invention, one of ordinary skill would need to be motivated to add circuitry for *generating* random passwords, rather than merely

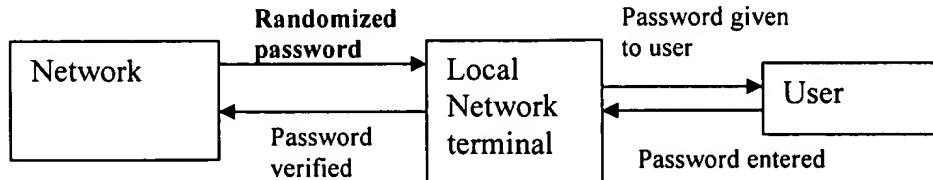
*storing* passwords entered by the user of the device. While *He* teaches that randomized passwords are beneficial for improving network security, the reference does not motivate or suggest generating randomized passwords *at the user side*. In other words, in a system including the device of *McIntosh*, *He* motivates a network or server that randomly generates passwords and then transmits the generated password to the user for storage in the device. For example, in the Examiner's proposed combination, a *He* bank server would generate a randomizing password and then send it to the account holder, who then stores it in the *McIntosh* device. *He* lacks the necessary motivation, however, to alter the storage device of *McIntosh* to form the claimed invention as *He* only teaches improving security with randomized passwords generated at the *server* side, rather than the *user* side.

Following is a schematic representation of *McIntosh* and *He* illustrating how a combination of the teachings in each reference still would not form the claimed invention:

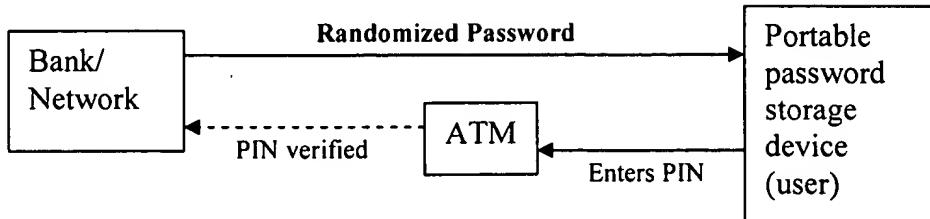
System of *McIntosh*:



System of *He*:



Modified McIntosh according to He:



Thus, the motivation relied on by the Examiner does not suggest the claimed invention as required by 35 U.S.C. § 103(a).

The non-obviousness of the claimed invention in light of the cited references is in accordance with established Federal Circuit precedent on the proper application of the standard of obviousness. As explained by the court in *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the **desirability of making the specific combination** that was made by the applicant. (internal citations omitted) (emphasis added)

The court in *Kotzab* subsequently overturned the Patent Office finding that the claimed invention covering a single sensor controlling multiple valves was obvious in light of the prior art disclosing multiple sensors controlling multiple valves. In particular, the court stated that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to **the specific understanding or principle within the knowledge of a skilled artisan that would have**

*motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.*

*Id.* at 1371 (emphasis added). Here, as the court in *Kotzab* said is often likely to occur, the Examiner found references that individually disclose many of the elements claimed by the Applicant. The Examiner did not, however, properly identify how one of ordinary skill would be *motivated to make the claimed combination* as the Examiner did not identify a specific motivation to randomize passwords at the user side for contemporaneous storage with indicia identifying the secure sites. Instead, the motivation or suggestion in the cited references relates to an abstract teaching that randomized passwords are more secure than non-randomized passwords. Moreover, this teaching was limited to server or host-side randomizing – not randomizing by the user. Thus, the Examiner rejected what appeared at first blush to be a simple concept (the combination of a random password generator and storage mechanism in a single, portable, user side device) based on the improper hindsight combination of references that do not truly motivate the combination in the manner claimed by Applicant, in direct contravention of *Kotzab*.

### **III. Impropriety of the Rejections under 35 U.S.C. § 103(a) in view of *McIntosh* and *Noll***

*Noll*, like *He*, simply describes an apparatus for creating random passwords and discloses that random passwords are better than non-random passwords. While *Noll* certainly motivates the general use of randomized passwords over non-randomized passwords to improve security, it fails to provide the necessary motivation to modify the structure of *McIntosh* to include circuitry for generating random numbers for association with the indicia of secure sites as presently claimed. As described with regard to *He* above, a general suggestion that a random password is better than a non-random password is legally insufficient to render the claimed invention obvious

under *Kotzab* and the standard required by 35 U.S.C. § 103(a) because it fails to motivate the making of the claimed combination.

#### **IV. Impropriety of the Rejections under 35 U.S.C. § 103(a) in view of the PassMan website**

The PassMan website does not qualify as prior art, as it is not a “printed publication,” and therefore cannot be used to form an obviousness rejection. If a reference does not include a publication date (or retrieval date), it cannot be relied on as prior art. MPEP § 2128. The PassMan website does not include either date; rather, the Examiner relies on information provided from the “Wayback Machine” to establish an archival or “cache” date. The cache dates provided by the Wayback Machine do not necessarily reflect the actual content of the website on a particular date, however, and thus cannot comprise “publication” dates.

The PassMan website was purportedly archived on April 28, 1999, but contains links to material that was clearly not available on that date. For example, the April 28, 1999 cached PassMan website purportedly links to a ZDNet review of the PassMan software (which the Examiner also included and relied on). The ZDNet review, according to its own disclosure, was not published until **September 1, 1999**. The PassMan website thus could not exist in the form relied on by the Examiner on April 28, 1999, as it could not contain a link to article that would not publish for another four months. Although the ZDNet article states that the software was “reviewed” on April 7, 1999, the **publication date** (and thus the legally operative date) on the face of the article is September 1, 1999. Indeed, the ZDNet article was not cached by the Wayback Machine until **September 9, 1999**. *See Exhibit A* (source code including cache date). Thus, the cached PassMan website clearly could not have contained all of the information relied on by the Examiner, as some of the content did not exist yet.

This unreliability of the cache dates is further established by reviewing the PassMan website as it was purportedly cached on December 6, 1999 and February 9, 1999. Both of these cached versions also contain a link to the ZDNet review – **at least four months before the review even occurred!** Thus, the cache date relied on by the Examiner to establish that the PassMan website qualifies as a “printed publication” is entirely unreliable and does not establish that certain content existed on a certain day. Because of these glaring inconsistencies in date and utter lack of contextual reliability, the reference fails to qualify as a “printed publication” for prior art purposes. MPEP § 2128.

Regardless, the “screen shots” relied on by the Examiner as actually disclosing portions of the claimed invention lack any sort of publication date, or even a cache date, that is prior to the filing of the present application. As a result, the “screen shots” were improperly relied on by the Examiner as they do not qualify as prior art. MPEP § 2128. The mere fact that the PassMan webpage has a link to the screen shots does not establish that those screen shots were in fact publications as of the date that the PassMan website was purportedly cached. Indeed, the screen shots were not archived by the Wayback Machine until **September 22, 1999**, more than two months after the present application was filed. *See Exhibit B* (source code including cache date). While the Examiner provided cache dates for the website itself, he neglected to include the cache dates for the linked material he relied on as rendering the claimed invention obvious. As the cache dates for the “screen shots” and ZDNet review clearly indicate, however, this material was not publicly available until after the present application was filed, and thus cannot render the claimed invention obvious.

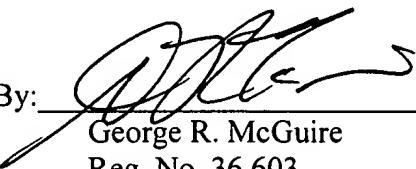
Regardless of whether the PassMan website qualifies as prior art, submitted herewith is the Declaration of Joseph Grajewski establishing, with the support of attached documentation,

that the present invention was conceived prior to the earliest available date for the PassMan website. Moreover, the claimed invention was subsequently and diligently constructively reduced to practice (by the preparation of a draft patent application on or before April 26, 1999 and the filing of this application on July 19, 1999). Dates on documents have been redacted in accordance with MPEP § 715.07, and attorney client privileged information has been withheld and explained in accordance with 37 CFR 1.131(b). Applicant hereby contends that the evidentiary showing established by the Grajewski Declaration and supporting exhibits is sufficient to eliminate the PassMan website from consideration, if it even qualifies as a "printed publication."

Enclosed herewith is Change of Correspondence form and a Petition for a One Month Extension and a check for \$55.00.

In view of the foregoing supporting remarks, the Examiner's reconsideration is requested and allowance of the present application is believed to be in order. If the Examiner believes a phone conference with Applicant's attorney would expedite prosecution of this application, he is respectfully requested to contact the undersigned at (315) 218-8515.

Respectfully submitted,

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